REMARKS

Claims 2-4, 6-10 and 23 are pending. In view of the Appeal Brief filed on June 23, 2004, prosecution has been reopened.

Claims 2-4, 6-10 and 23 are rejected under 35 USC § 103(a) as being unpatentable over Johnson et al. (U.S. Patent No. 5,813,009) and in view of the article by Joseph Radigan "The Nuts and Bolts of Toeing the Line." The rejection is respectfully traversed.

The combination of Johnson and Radigan do not establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine Johnson and Radigan. Johnson teaches managing records of various formats. Johnson normalizes multiple versions to the most recent version and deletes redundant files. Col. 6, lines 15-38. Radigan teaches that mortgage information is not in a standard format. "[E]ven when a bank has mapped the data by census tract, it still isn't in the format that regulators want. For whatever reason, regulators and lenders have been talking in two different languages." Radigan, page 2. However, Radigan states that it "is unclear if [the mortgage associations] will harmonize their efforts." Radigan, pages 2-3. Radigan does not desire a system that manages records of various formats, but rather a system that communicates in a standardized format. Johnson's system does not resolve the problem addressed by Radigan. Radigan only poses a problem rather than a solution and that problem is not even Johnson's

problem. Therefore, one of ordinary skill in the art would not be motivated to combine Johnson and Radigan.

Furthermore, there is no reasonable expectation of success. Because Radigan only identifies a problem rather than providing a system that resolves it, there is no reasonable expectation that the combination of Johnson and Radigan will succeed. Radigan states that "progress is coming a step at a time." Radigan, page 3. At the time this article was written, one of ordinary skill in the art was not in possession of standardized application data. "[N]o program suits every bank." Radigan, Abstract. Radigan suggests that "the dream of an all-encompassing system ... would take the application data, store it, retrieve and plot it against computerized census tract images, and finally transmit it to baking regulators in the format they've specified." Radigan, page 2. But Radigan asks, "Why hasn't such a system been produced?" Radigan alone does not provide a reasonable expectation of success. The teachings and suggestions of Johnson do not cure the deficiencies of Radigan to propose a system that is expected to succeed.

Moreover, Johnson and Radigan do not teach or suggest all the claim limitations. For example, Claim 23 recites in pertinent part "parsing a first portion of the normalized data so as to form parsed data." On page 6 of the Office Action, the Examiner states that "Johnson does not disclose [parsing] a first portion of the normalized data so as to form parsed data." Johnson teaches that "filter 3 captures incoming external information, as well as record data units of information created within the enterprise, and parses the information for further processing." Col. 9, line 54-57. However, Johnson is not teaching or suggesting the parsing of normalized data, but rather parsing the external data when it is captured. Radigan does not cure the deficiencies of Johnson. However, Therefore, Johnson and Radigan fail to teach or suggest this claim limitation.

The Examiner further states, "It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of conforming to statutory reporting requirements by financial institutions." However, one of ordinary skill in the art would not find it obvious to

"parse a first portion of the normalized data" in order to conform to statutory reporting requirements. One of ordinary skill may explore many avenues to "conform to statutory reporting requirements," but it is certainly not obvious to parse a first potion of normalized data to do so. The Examiner's use of obviousness in view of one of ordinary skill, for the rejection of various limitations in Claim 23, is a reconstruction based on hindsight reasoning. The Examiner is improperly relying on knowledge gleaned from the disclosure, rather than one of ordinary skill in the art. See MPEP § 2145. The Examiner's improper obviousness rejections for other claim limitations are further addressed below.

Claim 23 recites in pertinent part "geo-coding a second portion of the normalized data and the parsed data so as to form geo-coded data." On page 6 of the Office Action, the Examiner states that "Johnson does not explicitly disclose geo-coded data. Radigan discloses geo-coded data/page 1. Neither explicitly disclose a second portion of the normalized data and the parsed data so as to form geo-coded data." The undersigned representative agrees with the Examiner that Johnson provides no disclosure of geocoded data. Additionally, Radigan does not teach or suggest a method for geocoding a second portion of the normalized data and the parsed data so as to form geo-coded data. Radigan suggests that "the CMSI system Integra will install boasts a geocoding function, whereby street addresses are matched with their census tracks. However, ... Integra will have to modify Lakewood's Control Z before it can perform the geocoding function." Radigan, page 3. Radigan continues to discuss what a geocoding function might accomplish, assuming Integra may be able to provide a geocoding function. Therefore, this claim limitation could not have been obvious to one of ordinary skill in the art. Nevertheless, the combination of Johnson and Radigan does not teach or suggest geocoding normalized or parsed data.

Claim 23 recites in pertinent part "determining if the currently stored normalized data differs from previously stored normalized data or if the currently stored geo-coded data differs from previously stored geo-coded data." Johnson does not teach or suggest determining if the currently stored normalized data differs from

previously stored normalized data or if the currently stored geo-coded data differs from previously stored geo-coded data. Johnson does detect redundant files, but does not differentiate between normalized data and geocoded data. Instead, Johnson teaches the <u>deletion</u> of a redundant file, rather than a <u>comparison</u> of current and previous files for analysis. "Where redundancy is detected, the record (e.g., file) is deleted from the processing stream and sent to hold area 4." Col. 10, lines 6-8. Radigan does not cure the deficiencies of Johnson. Therefore, neither Johnson or Radigan teach or suggest "determining if the currently stored normalized data differs from previously stored normalized data or if the currently stored geo-coded data differs from previously stored geo-coded data."

Claim 23 recites in pertinent part "integrating the currently stored normalized data with the previously stored normalized data so as to form integrated normalized data if the currently stored normalized data differs from the previously stored normalized data." Johnson teaches a method for <u>tracking</u> duplicate files, not <u>integrating</u> files together. "[T]he available imaging systems do not track duplicate copies of stored records which may have been retained on paper or in other form within an organization that inadvertently may not have been destroyed when other copies of the file were purged." Col. 2, lines 16-20. The system in Johnson deletes duplicate files. "Where redundancy is detected, the record (e.g., file) is deleted from the processing stream and sent to hold area 4." Col. 10, lines 6-8. Further, the Examiner cites Johnson for the proposition that Johnson "integrates" files. See, e.g., col. 1, line 62 – col. 2, line 15. However, Johnson integrates "imaging, electronic document management and records management principles," but does not integrate current data with previously stored data. See col. 4, lines 14-16. Therefore, Johnson teaches tracking and deleting duplicate files rather than integrating currently stored normalized data with previously stored normalized data. Radigan does not cure the deficiencies of Johnson.

Claim 23 recites in pertinent part "preparing reports from either a combination of the integrated normalized data and integrated geo-coded data or from a combination of currently stored normalized data and currently stored geo-coded

data." On page 7, the Examiner cites Johnson for this claim limitation. See col. 16, lines 31-64; col. 26, lines 34-45. However, neither the citations nor the remainder of Johnson teach or suggest preparing reports from the combination of data. The undersigned representative respectfully requests that the Examiner more precisely direct the undersigned representative to the location where Johnson teaches or suggests this claim limitation.

Therefore, the undersigned representative respectfully requests that the rejection of claim 23 under 35 U.S.C. §103(a) be withdrawn.
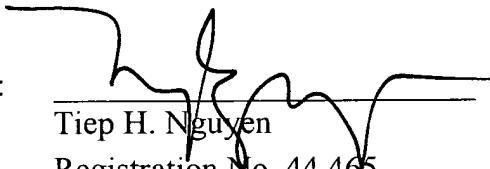
Though the undersigned has addressed the independent claim herein, it is clear from a review of Johnson and Radigan that the particulars of the dependent claims are also not disclosed by the reference cited. Accordingly, the undersigned submits that claims 2-4 and 6-10 are allowable over Johnson and Radigan.

CONCLUSION

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed September 22, 2004. The undersigned believes that claims 2-4, 6-10 and 23 are allowable over the cited prior art and respectfully requests a notice of allowance to this effect. Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

Date: ___1 | 24 | 2005___   By: _____

KILPATRICK STOCKTON LLP   Tiep H. Nguyen
607 14th Street, N.W., Suite 900   Registration No. 44,465
Washington, D.C. 20005
Phone: (202) 508-5800
Fax: (202) 508-5858